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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,178	10/16/2003	Tasneem S. Rangwala	38-21(52249)C	9566

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MONSANTO COMPANY
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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,178

Applicant(s)

RANGWALA ET AL.

Examiner

Joyce Tung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5, 7-8, 10 and 12-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The applicant's preliminary amendment 10/16/2003 has been entered. Claims 1-5, 7-8, 10, and 12-13 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a DNA molecule isolated from cotton tissue identified as SEQ ID NO 7, classified in class 536, subclass 22.1.
 - II. Claim 2, drawn to a primer pair of DNA molecules comprising a sufficient length of contiguous nucleotides of SEQ ID NO: 7, classified in class 536, subclass 24.3.
 - III. Claims 3, drawn to a DNA molecule isolated from cotton tissue identified as SEQ ID NO: 8, classified in class 536, subclass 22.1.
 - IV. Claim 4, drawn to a primer pair of DNA molecules comprising a sufficient length of contiguous nucleotides of SEQ ID NO: 8, classified in class 536, subclass 24.3.
 - V. Claim 5, drawn to a method of detecting the presence of DNA corresponding to the genomic/transgene DNA of cotton event PV-GHGT07(1445) event with a primer pair of claim 2, classified in class 435, subclass 91.2.
 - VI. Claim 7, drawn to a kit containing one DNA molecule of sufficient length of contiguous DNA polynucleotides to function in a DNA detection method, that is homologous or complementary to SEQ ID NO: 7, classified in class 435/536, subclass 810/24.3

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- VII. Claim 8, drawn to a method of detecting the presence of DNA corresponding to the genomic/transgene DNA of cotton event PV-GHGT07 (1445) event with a primer pair of claim 4, classified in class 435, subclass 91.2.
 - VIII. Claim 10, drawn to a kit containing one DNA molecule of sufficient length of contiguous DNA polynucleotides to function in a DNA detection method, that is homologous or complementary to SEQ ID NO: 8, classified in class 435/536, subclass 810/24.3
 - IX. Claim 12, drawn to an isolated DNA molecule comprising a genomic/transgene DNA junction sequence of cotton event PV-GHGT07 (1445) identified as SEQ ID NO: 5, classified in class 536, subclass 22.1.
 - X. Claim 13, drawn to an isolated DNA molecule comprising a genomic/transgene DNA junction sequence of cotton event PV-GHGT07 (1445) identified as SEQ ID NO: 6, classified in class 536, subclass 22.1.
2. The inventions are distinct, each from the other because of the following reasons:
- a. Inventions I-IV, VI, VIII-X, and V, VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product groups I-IV, VI and VIII-X are drawn to a DNA molecule, which can be used in nucleic acid purification.

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b. Inventions V and VII are distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, both inventions are drawn to a method of detecting the presence of DNA corresponding to the genomic/transgene DNA of cotton event PV-GHGT07 (1445) event with a primer pair, but Invention V uses the primer pair of claim 2 and Invention VI uses the primer pair of claim 4. Thus, they have different designs, modes of operation, and effects

c. Among Groups I-IV, VI and VIII-X, they all are drawn to a DNA molecule. Different Groups are drawn to different DNA molecules such as Group I is drawn to a DNA molecule isolated from cotton tissue identified as SEQ ID NO 7, Group II is drawn to a primer pair of DNA molecules comprising a sufficient length of contiguous nucleotides of SEQ ID NO: 7, Group III is drawn to a DNA molecule isolated from cotton tissue identified as SEQ ID NO: 8, Group IV is drawn to a primer pair of DNA molecules comprising a sufficient length of contiguous nucleotides of SEQ ID NO: 8, Group VI, claim 7 is drawn to a kit containing one DNA molecule of sufficient length of contiguous DNA polynucleotides to function in a DNA detection method, that is homologous or complementary to SEQ DI NO:7, Group VIII, claim 10 is drawn to a kit containing one DNA molecule of sufficient length of contiguous DNA polynucleotides to function in a DNA detection method, that is homologous or complementary to SEQ ID NO:8, Group IX is drawn to an isolated DNA molecule comprising a genomic/transgene DNA junction sequence of cotton event PV-GHGT07(1445) identified as SEQ ID NO: 5 and Group X is drawn to an isolated DNA molecule comprising a genomic/transgene

DNA junction sequence of cotton event PV-GHGT07(1445) identified as SEQ ID NO: 6.

They are distinct inventions.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between products claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to

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otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (571) 272-0790. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joyce Tung *J.T.*
April 22, 2006

Kenneth R. Horlick
KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

5/1/06